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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,378	02/10/2005	Timothy J. Philpot	GB02 0130 US	4848

24738 7590 04/05/2007
 PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
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 SAN JOSE, CA 95131

EXAMINER

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
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3611

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/524,378

Applicant(s)

PHILPOT, TIMOTHY J.

Examiner

Joanne Silbermann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/30/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In claim 11 "a size corresponding to that of a standard credit card and/or standard business card" is confusing since credit cards and business cards are not the same size. Also, the use of "standard" is considered to be indefinite since this does not adequately describe any particular size or shape.

In each of claims 13 and 14 "the planar area of the computer readable storage medium" does not have antecedent basis.

Claim Objections

5. Claim 13 is objected to because of the following informalities: there is no period at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 10 and 13-15, as far as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Perego, EP 1,083,563 A1.

8. Perego discloses holder 2 to which computer readable storage medium 7 is detachably attached, the holder having a planar shape (Figure 1) and a size corresponding to a conventional credit card (column 2 lines 44-46). Based on the size of the storage medium shown (in Figures 4 and 5 for example) the planar surface of the holder is at least 100% greater than the planar area of the storage medium, as best as the claims can be understood.

9. Regarding claim 15, Perego teaches more than one storage medium on one card (column 5 lines 56-58).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego.

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12. Perego does not teach the specific dimensions of the holder, however as best as the claims can be understood, the size of a conventional (as taught by Perego) credit card is 54 mm by 85 mm and a thickness of less than 5 mm.

13. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego in view of Walker, US #5,533,614.

14. Perego does not teach how the memory units are assembled on the card, however Walker teaches optically read discs attached side-by-side on the same side of a holder. It would have been obvious to one of ordinary skill in the art to attach discs to the holder of Perego in the manner taught by Walker so that more than one disc may be seen at the same time.

15. Regarding claim 17, the holder is "adapted to hold" two small form factor optical discs.

Response to Arguments

16. Applicant's arguments filed 30 January 2007 have been fully considered but they are not persuasive.

17. Reciting the medium

18. Applicant argues that the medium need not be claimed since the holder can be distributed separately therefrom. However, Applicant attempts to describe the holder in terms of the medium (claims 13 and 14) by stating that the size of the holder is 75% greater than the planar area of the medium. If the medium is not part of the claimed invention, the size of the holder cannot be thus described. The size of the holder would be dependent on the medium, and if the medium is not definitely claimed then the size

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of the holder is not definite. The size of the holder would change depending on the medium used. This, then, results in an indefinite claim. It is assumed for purposes of examination that claims 13 and 14 claim the combination of the holder and the medium.

19. Standard size

20. As Applicant admits in the arguments, different countries have different sizes of credit cards. Applicant also admits that specially shaped credit cards do exist.

Applicant suggests that since most cards are of a certain size in this country at this time that that size should be considered "standard." Since this "standard" size is based on Applicant's opinion, and what is currently used in this country, it cannot be considered definite. Such a size may change in time (or in different countries, as explained by Applicant) and this would change the meaning of the claim. Based on this, the claim is considered indefinite.

21. Patentability of size

22. As described in the rejection, Perego describes a "conventional" size of credit card in the description of the holder. Applicant states that the primary reference (Perego) relates to a holder for standard DVDs, however the size is described as that of a conventional credit card, which is similar to Applicant's language. It is not clear at this time why Applicant believes that the "conventional" size in Perego is sufficient to hold a "standard" DVD.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US patent publications 2001/0042009 A1 (Montague) and

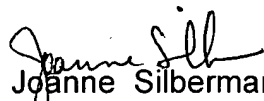
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2002/0027837 A1 (Weber) show different shapes and sizes of computer readable media and credit cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silbermann
Primary Examiner
Art Unit 3611

js
29 March 2007